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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/100,671	06/19/1998	JEFFREY MARK ZUCKER	19010.715	8812

5073 7590 06/29/2006

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DALLAS, TX 75201-2980

EXAMINER
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RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/100,671

Applicant(s)

ZUCKER ET AL.

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 70-92 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 70-92 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

This office action is in response to amendment filed April 12, 2006. Applicant amended the specification. Claims 70-92 are still pending.

***Priority***

Applicant is claiming a CIP of application No. 08/784,829 (US 6,119,101) filed 1/17/1997, which claim provisional to 60/010087 filed 1/17/1996 and to 08/970,470 (US 6,286,002), filed 11/14/1997. However these applications do not include the claimed subject matter applicant is claiming in the instance application, therefore, the current application cannot receive the benefit of the filing data of the parent cases (08/784,829) and 08/970,470 and also cannot receive the benefit of the provisional application (60/010,087) for the claimed invention. The parent cases do not disclose method and/or system for payment system as claimed in the current application.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 70-92 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Gabber et al. U.S. Patent No. 5,961,593.

Regarding claims 70-72, 77, 78 and 80 Gabber teaches establishing a pseudo payment associated with financial information to facilitated purchase, wherein the pseudo payment includes pseudo credit account, pseudo expiration data; pseudo identity, providing the pseudo payment to seller and charging the real account of the user; establishing the pseudo identity at a privacy server; (see col. 8 lines 18-62, col. 10 lines 22-65, col. 11 line 54 to col. 13 line 53). Gabber teaches transmitting payment from the financial institution to the second user on behalf of the first user under the pseudo credit account identifier. Gabber teaches the proxy system provides substitute identifiers that include the feature of anonymity, keeping the identity of the user secret that is the server sites (second user) cannot determine the true identity of the first user (see col. 8 lines 35-44). Gabber also teaches the substitute identifiers transmitted to the server site (on behave of the first user) (see col. 10 lines 41-65). Gabber further teaches the central proxy system includes functionality necessary to support electronic payment, the users employ electronic payment information to engage in anonymous commerce with the server sites, further the substitute identifiers may be constructed at least in part using credit/debit card number. Since in Gabber the substitute identifiers are transmitted to the second user from the proxy system to engage in anonymous communication between the user and the server sites, it is clear that the substitute identification created using the credit information is also sent to the second user from

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the proxy system on behalf of the first user during commerce transaction (see col. 12 lines 45-56).

Regarding claims 73-75 Gabber teaches establishing pseudo identity at proxy different from the central proxy when the user might not trust the central proxy (see col. 13 lines 27-53).

Claims 87, 88, 90 and 91 are rejected as stated above in claims 70-72, 77 and 78.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 76, 79, 89 and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabber further in view Official Notice.

Regarding claims 76, 79, 89 and 92, Gabber does not explicitly teach single use of credit account and identifying two actual payment type and establishing at a rule set defining when to use the each of the payment type. Official notice is taken that is well known in the art of e-commerce to set rules to define the use of accounts. Financial institutions allow account for single transaction or limited transaction or for specific use or transaction. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to include such rules in order to minimize fraud or misuse of credit cards.

Claims 81-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabber further in view Boies et al. (US 6,006,200).

Regarding claim 81-86, Boies teaches arranging an entity for delivering a product to recipient for the seller and withholding from the seller information that would permit the seller to determine the actual identity of the buyer; generating a code; transferring the item based on the code... (see fig 2A-2C and col. 2 line 1 to col. 3 line 6). It would have been obvious to one of ordinary skill in art at the time of the invention to combine Gabber's anonymous purchase with Boies's anonymous shipment system. One would be motivated to use Boies's shipping system for the purpose of providing a complete anonymity by protecting the identity of the buyer from the seller, as taught by Boies.

#### ***Response to Arguments***

Applicant's arguments filed October 13, 2005, have been fully considered but they are not persuasive.

Applicant argues that Gabber failed to teach communicating the pseudo credit account identifier and pseudo expiration data to the financial institution" and transmitting payment from the financial institution to the second user on behalf of the first user". Applicant asserts that that even though Gabber teaches that the requesting site upon verifying that the number originates from the central proxy with the understanding that it can collect the money from the central proxy system, Gabber does not disclose the money is collected. Applicant also argues that even if one were to assume Gabber discloses transmitting payment to the second user on behalf of the first user Gabber most certainly does not disclose that payment is transmitted from the financial institution to the second user under the pseudo credit account identifier.

Gabber teaches the proxy system generating an alias credit card number and sending it to a requesting site. The site accepts the same as valid, with the understanding that it can collect the

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money from the central proxy. In order to get paid by financial institution, in this case the proxy, the seller or requesting site is required to send the information including the sell made by the buyer to get payment from the institution in charge of the payment. In this case the only way the user, who made the purchase, is identified through the pseudo credit number. Therefore, it is inherent for the requesting site (seller) to send the pseudo credit card account identifier with the expiration date to the financial institution to receive the payment, since the seller does not have the real credit card identifier. Referring back to Applicant's specification, page 16, the specification indicates that the seller sends the pseudo payment type and the amount of the sale to the financial institution server for payment authentication. Further it discloses that the authentication is in the same manner that any other payment would be authenticated with any financial institution... the financial institution server then completes the payment authentication in the regular manner and generates an authorization code which is returned to the seller server again in the regular manner. Payment authentication is then complete. Nowhere in Applicants specification is explicitly disclosed that the financial institution transmits payment to the seller. The prior art provides the same support that the financial institution pays the seller for the product purchased by the buyer.

Regarding the Official Notice taken by the Examiner in regard to single use of credit account or different payment type and establishing a rule set defining when to use each of the payment type, Applicant argues that the Office Action failed to explicitly state for the basis for the Official notice including specific factual findings predicted on sound technical and scientific reasoning to support the conclusion of common knowledge. Mere request of a reference or affidavit to support the Official Notice is not adequate and does not shift the burden to the

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examiner to provide evidence in support of the Official Notice. Applicant does not indicate that the feature is not well known however wants the Examiner to provide a support. Allowing such statement would effectively destroy any incentive on the part of the Examiner to use Official Notice in the process of establishing a rejection of notoriously well known facts. Examiner provided a proper prima facie conclusion of obviousness, therefore the Examiner's taking of Official Notice has been maintained and since applicant does not reasonably traverse the well known statement, then it is an admitted art.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
**RETTA YEHDEGA**  
**PRIMARY EXAMINER**

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